

### **REMARKS**

Claims 26-62 are pending in the application. Claims 1-25 are canceled in this Response without prejudice to refiling. Claims 59-62 are newly added. Claims 26-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Pat. No. 6,561,288; U.S. Pat. No. 6,357,523; U.S. Pat. No. 6,280,000; U.S. Pat. No. 6,668,918; and U.S. Pat. No. 6,478,085. Claims 26-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of co-pending applications 10/641,856; 10/323,192; and 10/256,412. Claims 35, 38, 39 and 54 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stanley (U.S. Pat. No. 5,411,104). Claims 40, 42-45 and 49 are rejected under 35 U.S.C. § 102(b) as being anticipated by Smith (U.S. Pat. No. 5,435,400). Claims 40, 41, 46, 48 and 50 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mueller (U.S. Pat. No. 5,355,967). Claims 40, 42, 43, 51 and 52 are rejected under 35 U.S.C. § 102(b) as being anticipated by Allen (U.S. Pat. No. 4,134,463). Claims 26, 27, 31-34, 47 and 54-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller in view of Stanley. Claims 26, 28-30, 35-37, 53-55, 57 and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Stanley. Applicant respectfully requests reconsideration of the application in view of the remarks and amendments herein.

### **Double Patenting**

Claims 26-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Pat. No. 6,561,288; U.S. Pat. No. 6,357,523; U.S. Pat. No. 6,280,000; U.S. Pat. No. 6,668,918; and U.S. Pat. No. 6,478,085. Claims 26-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of co-pending applications 10/641,856; 10/323,192; and 10/256,412. Although Applicant disagrees that claims 26-58 are not patently distinct from the patents mentioned above, in the interest of expediting prosecution, Applicant is submitting herewith a terminal disclaimer. Accordingly, Applicant respectfully requests withdrawal of the obviousness-type double patenting rejection of claims 26-58. Applicant reserves the right to file

a terminal disclaimer with respect to the applications mentioned above when such applications are patented.

### **Claim Rejections - 35 U.S.C. § 102**

Claims 35, 38, 39 and 54 are rejected under 35 U.S.C. § 102(b) as being anticipated by Stanley (U.S. Pat. No. 5,411,104). Independent claim 35, as amended, recites the step of drilling a well "using a drilling fluid comprising liquid." Independent claim 54, as amended, includes similar limitations. Stanley, however, fails to disclose drilling a well using drilling fluid comprising liquid. In fact, as is discussed in more detail below, Stanley teaches away from use of a drilling fluid comprising liquid. Thus, Stanley fails to anticipate independent claim 35, dependent claims 38 and 39, and independent claim 54. Accordingly, Applicant respectfully requests withdrawal of the rejection to these claims under 35 U.S.C. § 102(b).

Claims 40, 42-45 and 49 are rejected under 35 U.S.C. § 102(b) as being anticipated by Smith (U.S. Pat. No. 5,435,400). Independent claim 40, as amended, recites "drilling a well bore in a coal seam." Smith fails to disclose drilling a well bore in a coal seam. Thus, Smith fails to anticipate independent claim 40 and dependent claims 42-45 and 49. Accordingly, Applicant respectfully requests withdrawal of the rejections to these claims under 35 U.S.C. § 102(b).

Claims 40, 41, 46, 48 and 50 are rejected under 35 U.S.C. § 102(b) as being anticipated by Mueller (U.S. Pat. No. 5,355,967). Independent claim 40, as amended, recites "drilling a well bore in a coal seam." Mueller fails to disclose drilling a well bore in a coal seam. Thus, Mueller fails to anticipate independent claim 40 and dependent claims 41, 46, 48 and 50. Accordingly, Applicant respectfully requests withdrawal of the rejections to these claims under 35 U.S.C. § 102(b).

Claims 40, 42, 43, 51 and 52 are rejected under 35 U.S.C. § 102(b) as being anticipated by Allen (U.S. Pat. No. 4,134,463). Independent claim 40, as amended, recites "drilling a well bore in a coal seam." Allen fails to disclose drilling a well bore in a coal seam. Thus, Allen fails to anticipate independent claim 40 and dependent claims 42, 43, 51 and 52. Accordingly,

Applicant respectfully requests withdrawal of the rejection to these claims under 35 U.S.C. § 102(b).

### **Claim Rejections - 35 U.S.C. § 103**

Claims 26, 27, 31-34, 47 and 54-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller in view of Stanley. Independent claim 26, as amended, recites "pumping a drilling fluid comprising a liquid down a drill string to a bit drilling a well bore in a coal seam." Claim 47 and independent claim 54 similarly recite use of a drilling fluid comprising liquid for drilling in coal. It would not have been obvious to use the Mueller process in a coal seam, because Mueller teaches use of a liquid drilling fluid. Stanley, however, teaches away from using drilling fluid comprising liquid. For example, at column 3, lines 33-37 Stanley teaches that its system uses gas for cuttings removal and bit cooling to minimize damage which would purportedly occur if a liquid system is used. Further, at column 3, lines 53-60, Stanley teaches that other drilling systems in coal have been economic failures, because mud and cuttings flow into the existing natural fractures and damage the wells. Therefore, Stanley teaches away from combination with Mueller. Accordingly, Applicant respectfully requests withdrawal of the rejections to claims 26, 27, 31-34, 47 and 54-56 under 35 U.S.C. § 103(a).

Claims 26, 28-30, 35-37, 53-55, 57 and 58 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Stanley. As is discussed above, independent claim 26 and 54 recite a drilling fluid comprising liquid. Independent claim 53 includes a similar limitation. It would not have been obvious to use the Smith process in a coal seam, because Smith teaches use of a liquid drilling fluid. Stanley teaches away from using drilling fluid comprising liquid, and thus teaches away from combination with Smith. Accordingly, Applicant respectfully requests withdrawal of the rejections to claims 26, 28-30, 35-37, 53-55, 57 and 58 under 35 U.S.C. § 103(a).

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### Conclusion

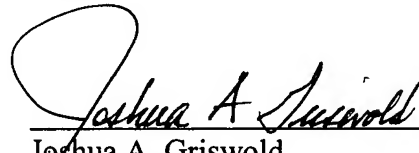
Applicant respectfully submits that the application is in condition for allowance, and requests such a Notice. If there are any outstanding issues or if the application is not allowed and/or one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

Enclosed is a \$330.00 check for claims fees (4 x \$50 = \$200) and terminal disclaimer fees (\$130) and a \$120 check for the Petition for Extension of Time (one month) fee. Please apply any deficiencies or any other required fees or any credits to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

Date: \_\_\_\_\_

12/30/04



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